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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,412

07/17/2003

Takuro Nishimura

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EXAMINER

POPOVICS, ROBERT J

ART UNIT

PAPER NUMBER

1724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/620,412

Applicant(s)

NISHIMURA ET AL.

Examiner

Robert J. Popovics

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on January 28, 2007 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **October 31, 2006** has been entered.

### ***Claim Rejections - 35 USC § 103***

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of **AAPA** (Applicants' Admitted Prior Art) and ***The Handbook of Separation Techniques for Chemical Engineers 2<sup>nd</sup> Edition (1988)***.

AAPA teaches:

[0003] 2. Description of the Related Art

[0004] In a process for producing a cellulose acylate film, a cellulose ester flake is first dispersed in a solvent and the mixture is stirred, preparing a cellulose acylate solution. Next, the cellulose acylate solution is subjected to filtration to remove foreign matters, thereby eliminating the possibility of defects in the film after film-formation. The filtered cellulose acylate solution is then formed to a film by co-casting or the like and the film is dried, thereby producing a cellulose acylate film.

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[0005] The above-described filtration of the cellulose acylate solution is carried out for the purpose of removing foreign matters in a dope such as undissolved matters and insoluble matters, thereby preventing the occurrence of defects in the formed film. As a filtering material for the filtration, filter paper, filter cloth, sintered metal or the like is used. In any filtering material, pores of the filtering material may be plugged with time, causing a sudden increase of pressure difference in the later half of the filtration. Thus, it is necessary to periodically pass a cleaning solution through the filtering material to clean the filtering material to regenerate it.

[0006] Filtering materials having an absolute filtration accuracy of approximately 0.01 mm have been used in the current filtration. The filtration accuracy required is expected to be higher in future. In particular, for the cellulose acylate film for a liquid crystal display of recent years, high quality is required compared with the cellulose acylate film for photography, so that the absolute filtration accuracy needs to be improved.

[0007] However, a reduction of the pore size of a filtering material for the purpose of improving the absolute filtration accuracy will soon make the filtering material plugged, extremely reducing the life of filtration. In addition, the process for producing the cellulose acylate film has become faster in recent years, causing a reduction of time until occurrence of filtration plugging. The reduction of the time to the plugging of the filtration material increases cleaning frequency, thereby increasing the load for operators.

[0008] Furthermore, when the pore size of a filtering material is reduced, there will be such problems that high filtration pressure is necessary and it takes a long time in filtration, thereby reducing productivity.

***AAPA does not appear to mention the use of filter aids. The Handbook of Separation Techniques for Chemical Engineers 2<sup>nd</sup> Edition (1988) teaches the use of filter aids to lengthen the***

filtration cycle. Among the well known filter aids disclosed by The Handbook are silica, perlite and wood pulp (pg 4-12). In view of this disclosure, it would have been readily apparent to one skilled in the art to employ these well known filter aids in the system disclosed by AAPA in order to lengthen the filtration cycle, thereby enhancing the economic efficiency of the process.

The dependent claims specify various percentages, particle size ranges, standard deviations, densities, thicknesses, terminal velocities, etc. These parameters are not seen to patentably distinguish the instant claimed invention over the references as applied above. Presumably, Applicants' obtain the filter aids used from commercially available sources. It is submitted that those parameters specified with respect the physical properties of the filter aids would be met by the commercially supplied filter aids. The other parameters are submitted to be met by virtue of inherency, or alternatively, that they constitute parameters that would have been routinely optimized by those skilled in the art.

As for the newly added limitation "**coarse**" – the skilled artisan must be credited with some minimal level of intelligence. Surely, the ability to optimally select suitable support media for a filtration aid would be within his purview, given the scope and

content of the prior art. Accordingly, this newly added limitation is considered obvious.

### ***Claim Rejections - 35 USC § 112***

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation ***“coarse-mesh”*** as it appears in amended claim 1 does not appear to be supported by the originally filed specification.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation ***“coarse,”*** as it appears in amended claim 1 is relative and subjective. As such, it renders the claims vague and indefinite because it is subject to numerous possible interpretations.

## ***Response to Arguments***

Applicant's arguments filed **January 28, 2007** have been fully considered but they are not persuasive. Applicants have asserted that the added limitation ***“coarse-mesh”*** defines over the prior art. The Examiner respectfully disagrees, in that the skilled artisan must be credited with the intelligence needed to select a proper support for a filtration aid. Furthermore, this recitation does not appear to find support in the originally filed specification, apparently constituting prohibited ***“new matter.”*** Applicants are directed to MPEP Section **714.02**, where it is urged, ***“Applicant should also specifically point out the support for any amendments made to the disclosure.”***

## ***Information Disclosure Statement***

In the spirit of compliance with **37 CFR 1.56, 1.97 and 1.98**, Applicants are urged to reveal the ***“mystery art”*** (i.e., AAPA) discussed in Applicants' specification, and provide citations thereof on a PTO-1449.

It is noted that no Information Disclosure Statements are of record. It is requested that Applicants confirm that no Information Disclosure Statements were filed.

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Additionally, MPEP Section 2001.06(b) [R-2] is noted:

**2001.06(b) [R-2] Information Relating to or From Copending United States Patent Applications**

The individuals covered by 37 CFR 1.56 have a duty to bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications which are ***“material to patentability”*** of the application in question. As set forth by the court in Armour & Co. v. Swift & Co., 466 F.2d 767, 779, 175 USPQ 70, 79 (7th Cir. 1972):

[W]e think that it is unfair to the busy examiner, no matter how diligent and well informed he may be, to assume that he retains details of every pending file in his mind when he is reviewing a particular application . . . [T]he applicant has the burden of presenting the examiner with a complete and accurate record to support the allowance of letters patent.

See also MPEP § 2004, paragraph 9.

Accordingly, the individuals covered by 37 CFR 1.56 cannot assume that the examiner of a particular application is necessarily aware of other applications which are ***“material to patentability”*** of the application in question, but ***must*** instead bring such other applications to the attention of the examiner. See Dayco Prod., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1365-69, 66 USPQ2d 1801, 1806-08 (Fed. Cir. 2003). For example, if a particular inventor has different applications pending in which similar subject matter but patentably indistinct claims are present that fact ***must*** be disclosed to the examiner of each of the involved applications. Similarly, the prior art references from one application ***must*** be made of record in another subsequent application if such prior art references are ***“material to patentability”*** of the subsequent application. See Dayco Prod., 329 F.3d at 1369, 66 USPQ2d at 1808.

(Emphasis added by Examiner)

Any inquiry concerning this communication should be directed to Robert J. Popovics at telephone number (571) 272-1164.



Robert James Popovics  
Primary Examiner  
Art Unit 1724

